

### **REMARKS**

The present claim rejections appear to be based entirely on the examiner's concerns regarding an alleged lack of clarity with respect to the conditions under which an enhanced channel report is transmitted in various embodiments of the present invention. Although the Applicant traverses several of the Office Action's specific findings, the claims have been amended in a manner that renders the examiner's concerns moot. Accordingly, the rejections of the pending claims should be withdrawn, and the pending application allowed to issue. After seven examinations of claims substantially similar to those currently pending, Applicant submits that the pending claims meet the requirements for patentability and are immediately allowable. A notice of allowance is thus respectfully requested.

#### ***Amendments to the Claims***

Independent claims 1 and 21 have been amended in response to the Office Action dated January 5, 2009. In particular, independent method claim 1 has been amended to recite that the claimed method includes a mobile terminal determining "whether" a condition is satisfied rather than determining "if" a condition is satisfied. Further, method claim 1 has been amended to clarify that the mobile terminal selectively provides an enhanced channel report "if said condition is satisfied", rather than "based on said determining." Apparatus claim 21, which corresponds closely to method claim 1, has been amended in a similar fashion. These clarifying amendments are fully supported by the specification as filed, including at least at ¶ [0019].

#### ***Rejections under 35 U.S.C. § 112***

The Applicant was surprised to find that alleged problems with both the first and second paragraphs of 35 U.S.C. § 112 have arisen for the first time in the present Office Action, which marks the seventh Office Action in this matter. Nonetheless, the Applicant appreciates the

opportunity to ensure that the claims are clear and fully supported. Although the Applicant traverses the Office Action's specific findings with regards to an alleged lack of enablement and alleged indefiniteness, independent claims 1 and 21 have been amended to clarify the invention. Furthermore, the Applicant notes that the specific concerns articulated in the Office Action are in fact not applicable to claims 52-63. In view of these amendments and the following discussion, Applicant respectfully requests the withdrawal of all rejections under 35 U.S.C. § 112,

Enablement under 35 U.S.C. § 112. Claims 1-14, 16-28, 30-34 and 52-63 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. According to the Office Action, "it is unclear to the Examiner and one skilled in the art how to make and practice the invention without clear direction." The examiner appears to be concerned that one reading claim 1 (as previously presented) would find it "impossible ... to understand and determine when or under what circumstance the enhanced channel report is provided."

Applicant respectfully submits that the claim as previously presented is completely enabled by the specification as filed, e.g., at least at paragraphs 19 and 29. The examiner's true concern seems to be that the claim as previously presented allowed for two distinct possibilities, that the enhanced channel reports could be selectively provided if the common feedback criterion were satisfied, or that the enhanced channel reports could be selectively provided if the common feedback criterion were not satisfied. However, the fact that a claim encompasses two or more alternative embodiments does not in itself create an enablement problem. In fact, both of these alternatives are addressed in the specification in terms readily understandable to one of ordinary skill in the art.

In any event, claims 1 and 21 as amended clearly recite that a basic channel report is

normally provided, and that an enhanced channel report is selectively provided if a condition based on at least one common feedback criterion is satisfied. These claims are fully enabled by the current specification. In any event, the current amendments render the examiner's specific concerns moot. Furthermore, the specific concerns raised by the Office Action are wholly inapplicable to independent claims 52 and 58, as neither of these claims recites the selective providing of enhanced channel reports as discussed in the Office Action. Withdrawal of the rejections of all claims under 35 U.S.C. § 112, first paragraph, is thus respectfully requested.

Indefiniteness under 35 U.S.C. § 112. Claims 1-14, 16-28, 30-34 and 52-63 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. These rejections appear to be closely related to the enablement rejections discussed above, and should be withdrawn for essentially the same reasons. First, the fact that a claim encompasses two or more alternative embodiments does create ambiguity or indefiniteness. Furthermore, the current amendments render the examiner's specific concerns moot. Finally, the specific concerns raised by the Office Action are wholly inapplicable to independent claims 52 and 58, as neither of these claims recites the selective providing of enhanced channel reports as discussed in the Office Action. Withdrawal of the rejections of all claims under 35 U.S.C. § 112, second paragraph, is thus respectfully requested.

***Rejections under 35 U.S.C. § 102***

Claims 1, 3-8, 21, 23, 24, 52, and 58 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Bark et al. (US 6,445,917). In light of the current amendments and the following discussion, these rejections should be withdrawn. In particular, Bark does not disclose a channel reporting method or apparatus in which basic channel reports are normally transmitted and in which enhanced channel reports are selectively transmitted if a condition

based on at least one common feedback criterion is satisfied, as claimed in independent claims 1 and 21. Furthermore, the Office Action's analysis is wholly inapplicable to independent claims 52 and 58, which are directed to a method in a base station and corresponding apparatus, respectively, for generating and transmitting common feedback criteria to mobile stations.

Independent claims 1 and 21. Independent method claim 1 reads, as amended:

*1. (Currently Amended) A method of reporting channel information in a wireless communication system, comprising:  
a mobile terminal normally providing a basic channel report, said basic channel report at least partially characterizing a downlink channel;  
said mobile terminal receiving at least one common feedback criterion broadcast to a plurality of mobile terminals;  
said mobile terminal determining whether said mobile terminal satisfies a condition based on said at least one common feedback criterion; and  
said mobile terminal selectively providing an enhanced channel report regarding said downlink channel if said condition is satisfied wherein said enhanced channel report provides a more detailed view of said downlink channel than said basic channel report.*

Independent claim 21 is directed to a corresponding apparatus having similar limitations.

According to the Office Action, Bark teaches the transmission of a measurement report when events have occurred, asserting that Bark's teaching "clearly reads on the limitation of 'selectively providing a channel report, either basic channel report or enhanced channel report based on the determining step'," and that "it happens to select the basic channel report ... in this case." The Office Action further states that "the teaching of enhanced channel report is not required." (Office Action, p. 5.)

Whether or not it was ever present in the claims, the paraphrased claim limitation analyzed in the Office Action is not in fact present in the presently pending claims 1 and 21. Rather, claim 1 recites "selectively providing an enhanced channel report ... if said condition is

satisfied”; claim 21 has a similar limitation. Since the Office Action admits that Bark teaches sending only basic channel reports, Bark clearly fails to anticipate claims 1 and 21. The rejection of claims 1 and 21, and their dependent claims 2-13, 16-28, and 30-34 should be withdrawn.

Independent claims 52 and 58. The present Office Action treats independent claims 52 and 58 as though they were substantially identical to independent claim 1. However, claims 52 and 58 are in fact directed to a base station apparatus and corresponding method that complement the mobile terminal-related claims 1 and 21. Claims 52 and 58 do not have the same limitations as claim 1, and the Office Action’s analysis with respect to these claims is incomplete and fails to establish a *prima facie* case of anticipation. Although Bark is generally directed to event-based reporting of mobile station measurements, Bark does not disclose a base station that receives basic channel reports from a plurality of mobile terminals and that determines and transmits common feedback criterion that define a condition whose satisfaction controls which of a subset of the plurality of mobile terminals subsequently transmit an enhanced channel report. The rejection of claims 52 and 58, as well as their dependent claims 53-57 and 59-63, should be withdrawn.

Dependent Claim Rejections. Because Bark fails to anticipate independent claims 1, 21, 52, and 58, the rejections of the pending claims, which depend on the teachings of Bark, should also be withdrawn. Although several of these rejections may be improper for additional reasons, it is not necessary to address those reasons in full at this time, in view of the present amendments and the above discussion. However, Applicant reserves the right to address specific findings of the present Office Action should they arise in a different context in future actions.

Applicant specifically traverses the rejections of dependent claims 2, 9-14, 18-20, 22, 25-28, 32-34, 53-57, and 59-63 under 35 U.S.C. § 103 as allegedly obvious over Bark in view of Sporre (US 5,966,657). Bark does not disclose a system in which basic channel reports are normally provided and enhanced channel reports are selectively provided, depending on satisfaction of a condition based on common feedback criterion transmitted to a plurality of mobile terminals. Sporre's alleged teachings regarding enhanced channel reports are insufficient to cure these deficiencies in the teachings of Bark, and thus no combination of the cited references actually yields the claimed invention.

***Conclusion***

The present claims, with only minor clarifying amendments, have now been examined seven times. In view of the current clarifying amendments and the above discussion, the pending claims are novel and non-obvious with respect to the cited art, and otherwise meet the requirements of the Patent Act. The Applicant therefore respectfully requests reconsideration of the pending application and immediate issuance of a notice of allowance.

Respectfully submitted,

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